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10/534,597	05/11/2005	Michael A. Epstein	US020438	3395
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EXAMINER				
RAVETTI, DANTE				
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3685				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/534,597

Applicant(s)

EPSTEIN, MICHAEL A.

Examiner

DANTE RAVETTI

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. This communication is in response to the original Application No. 10/534,597 filed on May 11, 2005.
2. Claims 1-10 are currently pending and have been fully examined.
3. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

### ***Priority***

4. Acknowledgement is made of Applicant's claim for priority to Provisional Application # 60/425,843 filed on November 12, 2002.

### ***Specification***

5. The Specification of this Application is objected to, for being in improper form or deficient the proper parts. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the Applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR §1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.

- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR §1.97 and §1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The appropriate correction of Applicant's Application is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup>***

6. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, Applicant recites, "...controller is configured to eliminate one or more effects...." It is unclear what "effects" Applicant is referring to. One of ordinary skill in the art would not be reasonably appraised of the scope of the invention. The appropriate correction is required.<sup>1</sup>

Claims 3-6 are also rejected for containing similar language or like deficiencies.

Claims 2-7 are also rejected for being dependent upon rejected claim 1.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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<sup>1</sup> In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989); An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...

9. Claims 1-7 are rejected under 35 U.S.C. §102(b) as being anticipated by Stefik et al., (US 5,638,443) ("Stefik").

**As to claim 1:**

Stefik expressly teaches:

a controller, operably coupled to a copy device, that is configured to maintain a log of prior copies of the source material, and to control the copy device dependent upon contents of the log (See at least (col. 6, lines 1-5), (col. 7, lines 32-40), (col. 26, lines 17-56), Table 1, 2, Figure 2, 4a); and

a marker device, operably coupled to the controller and the copy device, that is configured to attach an information item to one or more of the prior copies (See at least (col. 18, lines 20-26), (col. 19, lines 5-15), (col. 20, lines 62-67), (col. 21, lines 1-10), (col. 26, lines 65-67), (col. 31, lines 25-30), (col. 32, lines 60-65), (col. 31, lines 25-30), Table 1 ("A counter of the number of copies"));

wherein the information item includes an expiration time associated with each of the one or more of the prior copies (See at least (col. 21, lines 48-58), (col. 13, lines 64-67), (col. 18, lines 9-26), (col. 19, lines 5-16), (col. 21, lines 30-59), Table 1); and

the log includes the expiration time associated with each of the one or more prior copies (See at least (col. 13, lines 64-67), (col. 21, lines 47-58), (col. 22, lines 4-13), (col. 23, lines 41-47), Table 1), and

the controller is configured to eliminate one or more effects of having made at least one copy of the one or more of the prior copies after an expiration of the expiration time associated with the at least one copy (See at least (col. 11, lines 1-6), (col. 19, lines 55-67), (col. 20, lines 6-25), (col. 30, lines 52-67), (col. 31, lines 25-30), (col. 34, lines 1-5), (col. 35, lines 5-47), Table 1, Figure 18);

**As to claim 2:**

Stefik expressly teaches:

wherein the log includes an identifier of the source material, and the controller is configured to limit a total number of copies of the source material, based on the contents of the log (See at least (col. 8, lines 57-67), (col. 9, lines 1-15), (col. 13, lines 10-17), (col. 17, lines 61-67), (col. 18, lines 1-8), (col. 20, lines 63-67), (col. 31, lines 1-16), Table 1-2, Figure 7);

**As to claim 3:**

Stefik expressly teaches:

erase a returned copy of the one or more prior copy, and eliminate one or more effects of having made the returned copy (See at least (col. 2, lines 47-54), (col. 19, lines 20-35), (col. 20, lines 5-25), (col. 35, lines 1-10, 60-67), Table 1-2 (Level 5)).

**As to claim 4:**

Stefik expressly teaches:

wherein the controller is configured to eliminate the one or more effects of having made the returned copy via a modification of the log corresponding to the returned copy (See at least (col. 11, lines 15-20), (col. 12, lines 1-11), (col. 21, lines 1-10), (col. 31, lines 41-65), (col. 32, lines 1-6), (col. 35, lines 10-45), Table 1, Figure 18).

**As to claim 5:**

Stefik expressly teaches:

wherein the controller is configured to eliminate the one or more effects of having made the at least one copy after the expiration of the expiration time via a modification of the log corresponding to the at least one copy (See at least (col. 11, lines 1-5), (col. 19, lines 54-59), (col. 30, lines 60-67), (col. 35, lines 10-47), (col. 35, lines 47-67), Figure 16-18, Table 1);

**As to claim 6:**

Stefik expressly teaches:

wherein the controller is configured to eliminate the one or more effects of having made the at least one copy after the expiration of the expiration time via a modification of the log corresponding to the at least one copy (See at least (col. 11, lines 1-5), (col. 19, lines 54-59), (col. 30, lines 60-67), (col. 35, lines 10-47), (col. 35, lines 47-67), Figure 16-18, Table 1);

**As to claim 7:**

Stefik expressly teaches:

further including the copy device (See at least (col. 7, lines 10-15, 33-67), (col. 8, lines 1-15), (col. 42, lines 1-10), (col. 51, lines 8-13);

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over

Stefik and in view of Weinman, JR. (US 2002/0055972) ("Weinman").

**As to claim 8:**

Stefik teaches substantially as claimed:

maintaining a log of each copy of the source material, wherein the log includes an expiration time associated with at least one copy of the source material (See the discussion of claim 1);

updating the log after the expiration time of the at least one copy has expired (See at least (col. 11, lines 15-20), (col. 19, lines 42-53));

Stefik does not expressly teach:

creating a new copy of the source material only if the log indicates that a total number of outstanding copies of the source material is below a given limit;

so that the at least one copy is not included in the total number of outstanding copies of the source material after the expiration time of the at least one copy has expired.



However, Weinman expressly teaches:

creating a new copy of the source material only if the log indicates that a total number of outstanding copies of the source material is below a given limit (See at least [0010], [0012], [0015], [0034]-[0036], [0040], [0046]-[0047], Figure 6);

so that the at least one copy is not included in the total number of outstanding copies of the source material after the expiration time of the at least one copy has expired (See at least [0010], [0012], [0015], [0034]-[0036], [0040], [0046]-[0047], Figure 6);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Stefik to include the features of Weinman because it is a common practice in the field of content distribution, to take inventory of content and to make determinations on their integrity and functionality

**As to claim 9:**

Stefik expressly teaches:

further including updating the log when an identified copy of the source is returned, so that the identified copy is not included in the total number of outstanding copies of the source material after the identified copy is returned (See at least (col. 12, lines 1-11), (col. 20, lines 63-67), (col. 31, lines 1-67), (col. 35, lines 1-67), Table 1)

**As to claim 10:**

Stefik expressly teaches:

further including using a secure method of identifying the identified copy of the source (See at least (col. 7, lines 15-20), (col. 8, lines 57-67), (col. 9, lines 1-15), (col. 13, 17-25)).

12. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the applicant. Although the specified citations are representatives of the teachings in the art

and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, please contact the Electronic Business Center (EBC) at 1-(866)

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/Dante Ravetti/  
Examiner, Art Unit 3685  
Wednesday, September 24, 2008

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685